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EXAMINER

CHUONG, TRUC T

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHRISTOPHER A. MESA, JENNIFER L. MELIN, KAIRI ANN
JOHNSTON, DOUG KALTENECKER, and HONEE LEE MESA

Appeal 2009-001822¹
Application 09/944,659
Technology Center 2100

Decided: October 19, 2009

Before ALLEN R. MacDONALD, *Vice Chief Administrative Patent Judge*
JEAN R. HOMERE, and JAMES R. HUGHES, *Administrative Patent*
Judges.

HOMERE, *Administrative Patent Judge.*

DECISION ON APPEAL

¹ Filed August 31, 2001. The real party in interest is Hewlett-Packard Development Company, LP.

I. STATEMENT OF THE CASE ²

Appellants appeal under 35 U.S.C. § 134(a) from the final rejection of claims 25 through 27, 30 and 31. However, Appellants have not appealed the final rejection of claims 23, 24, 28 and 29. Claims 1 through 22 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Appellants' Invention

As shown in Figure 1, Appellants invented a scanner (110) that displays a user interface (114) from which a user can select one or more destination devices (120, 130, 140) to send data to one of the available resources (122, 124, 126, 132, 134, 136, 142, 144, 146) on the one or more selected destination devices. (Spec. 9, l. 10 - spec. 11, l. 21.)

Illustrative Claim

Independent claim 27 further illustrates the invention. It reads as follows:

A scanning method, comprising:

displaying a user interface from which one or more of multiple destination devices may be selected to receive data from an input peripheral having a scanning capability and from which a resource on one more of the

² The Examiner objects to Appellants' Specification for failing to provide proper antecedent basis for what is encompassed by the computer readable medium recited claims 28 and 31. Appellants appeal the objection. (App. Br. 7-8.) Because the Examiner's objection to the Specification is a petitionable matter as opposed to an appealable one, this issue is not properly brought before us.

multiple destination devices may be selected to receive data from the input peripheral;

the input peripheral notifying a selected destination device that the device and a resource on the device have been selected to receive data;

in response to the notifying, the selected destination device acknowledging a notification from the input peripheral; and

in response to an acknowledgement from the selected destination device, the input peripheral scanning a document and transmitting data representing the document to a resource on the selected destination device selected to receive data from the input peripheral.

Prior Art Relied Upon

The Examiner relies on the following prior art as evidence of unpatentability:

Monty	5,799,070	Aug. 25, 1998
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*Rejection on Appeal*³

The Examiner rejects the claims on appeal as follows:

Claims 25 through 27, 30 and 31 stand rejected as being anticipated by Monty.

³ Claims 23, 24, 28 and 29 also stand rejected as being anticipated by Monty under a new ground of rejection in the Examiner's Answer. (Ans. 3-5.) Since Appellants explicitly opt not to appeal this new ground of rejection of these claims (08/22/2007 App. Br. 2), we sua sponte dismiss the appeal as to these claims (see 37 C.F.R. § 41.39(b)).

Appellants' Contentions

Appellants contend that Monty does not teach selecting a resource on a selected destination device to receive data from an input peripheral, as recited in independent claim 27. (App. Br. 6, Reply Br. 1-2.) According to Appellants, while Monty discloses selecting the fax number of a destination device from a user interface, the reference does not indicate that the fax number is a resource on the destination device as required by the claim. (*Id.*)

Examiner's Findings

The Examiner finds that Monty's disclosure of selecting a fax number from the user interface of a scanner to thereby transmit data to a desired destination device teaches selecting a resource on a destination device to transmit data thereto. (Ans. 5-7.)

II. ISSUE

Have Appellants shown that the Examiner erred in finding that Monty teaches selecting a resource on a selected destination device to receive data from an input peripheral?

III. FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

Monty

1. As shown in Figure 1, Monty discloses a scanner having a user interface (10) with a speed dial button that displays one or more fax numbers associated with one or more destination devices respectively. Upon dialing a particular number, a corresponding destination device will be called such that the peripheral can transmit scanned data to the device via the selected fax number. (Col. 3, ll. 29, ll. 49-62.)

IV. PRINCIPLES OF LAW

Anticipation

In rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992)).

Anticipation of a patent claim requires a finding that the claim at issue ‘reads on’ a prior art reference. In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed. Cir. 1999) (internal citations omitted).

V. CLAIM GROUPING

Appellants argue the patentability of claim 27 in conjunction with the rejection of claims 25 through 27, 30 and 31. In accordance with 37 C.F.R. § 41.37(c)(1)(vii), we will consider the claims on appeal as standing and falling with representative claim 27.

VI. ANALYSIS

Independent claim 27 requires in relevant part selecting a resource on a selected destination device to receive data from an input peripheral.

As set forth in the Findings of Facts section, Monty discloses a scanner having a user interface from which a previously stored fax number is selected to designate a destination device corresponding thereto. (FF. 1.) Upon dialing the selected fax number, scanned data can be transferred to the destination device via the fax number. (FF. 1.) We find that upon selecting a pre-recorded fax number from the scanner display, the user designates a destination device associated with the selected number to transfer the data. We further find that since the claimed resource on destination device can be a telephone/fax number selected by the user to route the data (see Appellants' claim 25), Monty's disclosure of allowing the user to transmit data via the selected fax number designating a destination device teaches the claimed limitation. We therefore agree with the Examiner that Monty's selected fax number teaches both the destination device and a resource

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thereon since the claim does not preclude the resource and the destination device from being a single entity. It follows that Appellants have not shown that the Examiner erred in finding that Monty anticipates claim 27.

VII. CONCLUSION OF LAW

Appellants have not established that the Examiner erred in rejecting claims 25 through 27, 30 and 31 as being anticipated under 35 U.S.C. § 102(b).

VIII. DECISION

We affirm the Examiner's rejection of claims 23 through 31.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

dal/nhl

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